

REMARKS

Claims 1-25 remain pending in the application. Reconsideration is requested.

In the third non-final Action, dated October 21, 2004, claims 1, 4-9, 11-12, 14-16, and 20 were rejected as obvious over Schena (US20020001854) in view of Adams (5974548).

Schena is understood to disclose an arrangement for “bridging the gap between the virtual multimedia-based Internet world, and the physical world of tangible object media, such as print media.”¹ For example, Schena teaches that a handheld² scanner device can read a bar code from a newspaper or magazine. This bar code may encode URL data. The handheld scanner (which may be a cell phone) uses this URL data to obtain web page data, which is presented to the user on Schena’s handheld display.³

Adams concerns a different field of endeavor, *i.e.*, creating secure documents that are traceable to their origin, regardless of copying, and regardless of changes in media between copies.⁴

The rejections based on Schena/Adams are traversed on a number of grounds.

For one, the Action admits that Schena does not teach various of the claims’ limitations but asserts that Adams cures such deficiencies. Applicants disagree.

For example, the Action asserts that Adams teaches “storing said document image data in a data store, wherein the document image data can thereafter be accessed from the data store *by use of said binary identification data* [decoded from paper sheet scan data].”

Adams is not understood to work in such fashion. Nor does the Action even allege such operation.

Rather, the Action simply says “Adams discloses scanning a document with a pattern that is unreadable by human vision into a bit map and storing the document in a memory device.”⁵

¹ Schena Abstract.
² Schena at [0028].
³ Schena at [0091].
⁴ Adams, col. 1, lines 8-10.
⁵ October 21, 2004, Action, page 3, lines 6-8.

More is required by claim 1. For example, claim 1 further requires “*wherein the document image data can thereafter be accessed from the data store by use of [binary identification decoded from paper sheet scan data].*”

Adams is not understood to teach this limitation, and the Action has not alleged otherwise.

Thus, no combination of the teachings of Schena and Adams could yield the arrangement of claim 1.

A second grounds for traverse is the unsupported assertion that Adams is “in an analogous art.” It is not clear what boundaries of “analogous” are being applied, but it seems clear that Schena and Adams concern different fields: one dealing with “bridging the gap,” and the other dealing with tracing documents to their origin.

*“A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem.”*⁶ There is no explanation in the Action why an artisan would have looked to references as diverse as Schena and Adams.

A third grounds for traverse is deficiency in the rationale offered to explain why an artisan would have found it obvious to adopt certain teachings of Schena/Adams, modify others, and disregard still others, and jigsaw together the results in the manner needed to yield the claimed combinations. The only explanation offered in the Action is:

Therefore, one of ordinary skill in the art at the time the invention was made would have found it obvious to implement or incorporate storing image data in a data store and wherein a single scan permits acquisition of both image and identification data in Schena's system in order to present a back-up copy of the document.”

A “back-up copy” is thus the offered as the crux of the motivation. But Adams does not concern himself with this aim, and Schena (to the extent it is relevant to this ambition) purports to fulfill such a need without any modification.⁷ Accordingly, it is not

⁶ *In re Deminski*, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986); *In re Clay*, 966 F.2d 656, 659, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992).

⁷ Schena at [[0092].

seen that this motivation would have led an artisan to the radical restructuring of Schena proposed in the rejection.

Claim 12 is an independent claim that includes presenting “an adhesive sticker” to an optical sensor. No such teaching is evident from Schena or Adams. Indeed, no consideration of claim 12 is evident in the Action.

Because *prima facie* obviousness has not been established as to claims 1 and 12, applicants don’t belabor this response by particularly considering the rejections of claims dependent therefrom. (However, applicants would note that various of the rejected dependent claims include limitations not particularly addressed in the Action.)

Claims 2-3, 18-19, 21-22 and 25 were rejected as unpatentable over Schena and Adams, as above, and further in view of Hube (5,640,647).

Hube was cited and discussed in a previous Action/Response. His invention concerns a photocopier that selectively scans pages within a document stack – *excluding* certain pages from scanning. In particular, Hume teaches that a range of pages *not* to be scanned can be denoted by placing a first adhesive sticker on the first such page, and a second adhesive sticker on the last such page. A photocopier according to Hube’s invention incorporates a label sensor – prior to the document scanner – that looks for these stickers. When it finds a first sticker it causes that page, and subsequent pages, to be passed through the photocopier *without* being scanned/copied. When the label sensor finds one of the second sensors, it returns to normal photocopying operation with the next page.

It will be recognized that, in Hube’s arrangement, any page bearing a sticker is *not* scanned or copied. Only pages that are *without* a sticker are scanned (and not even all of these).

Hube’s teaching is thus directly *contrary* to applicants’ claimed arrangements, e.g., claim 2, that call for scanning paper sheets having optically-detectable indicia thereon. Such sheets are *not* scanned in Hube.

If Hube’s sheet has an optically detectable indicia (i.e., an adhesive label), then no scan data comprising document image data is produced.

(If the Examiner were to argue that the “sensor” at issue is Hube’s label sensor, rather than the page scanner, then the quoted statement fails because it is not this sensor that produces “scan data comprising document image data” required by claim 2.)

Accordingly, the citation of Hube is not believed to redress the shortcomings of Schena and Adams as regards claims 2-3, 18-19, 21-22, and 25.

Moreover, the rationale offered in support of the rejection of claim 2 is flawed. It states:

Therefore, one of ordinary skill in the art at the time the invention was made would have found it obvious to implement or incorporate the paper sheet comprises an adhesive note having the indicia on one side thereof, and a tacky adhesive on the other side thereof in Schena’s system in order for the scanner to know which documents to be skipped.”

The motivation “in order for the scanner to know which documents to be skipped” has no role in the invention of claim 2. No skipping of documents is referenced. Schena + Adams + Hube may theoretically lead to some sort of an invention, but not the one claimed by applicants.

Still further, the shortcomings noted earlier regarding deficiencies in the rejection of independent claims 1 likewise apply here, concerning claims 2-3.

Claim 18 is an independent claim drawn to “*A sheet of note-paper, the sheet having tacky adhesive on one side thereof, the sheet further having an optically-detectable indicia thereon, said indicia being machine-readable but not generally intelligible to a human viewer thereof.*”

The Action does not explain any relevance of Adams to this combination, but explains a proposed combination of Schena and Hube as follows:

Therefore, one of ordinary skill in the art at the time the invention was made would have found it obvious to implement or incorporate the paper sheet comprises an adhesive note having the indicia on one side thereof, and a tacky adhesive on the other side thereof in Schena’s system in order for the scanner to know which documents to be skipped.

Again, skipping of documents plays no role in the invention defined by claim 18. Moreover, it has no evident role in Schena – the invention which the Action proposes to modify by Hube.

Again, the Action has failed to provide a convincing line of reasoning that would have led an artisan to the claimed arrangement.

The rejections of claims dependent from claim 18 are similarly flawed, since these claims include each of the limitations of claim 18. (Again, certain of these claims also have limitations not particularly addressed in the Action – e.g., a payload of between 20 and 64 bits in claim 22. And certain of these claims also have features said to be taught by the art, but which are not – e.g., “texturing” in claim 25.)

Claims 10 and 23-24 stand rejected over Schena in view of Adams, and further in view of Reber (6,081,827).

The rejection of claim 10 is flawed because claim 10 depends from claim 1, and the rejection of claim 1 is flawed – as detailed above. Accordingly, this claim is not further considered.

Claims 23-24 depend from claim 18. The (flawed) rejection of claim 18 notes that Schena is inadequate without Hube. However, Hube is not cited against claims 23-24. Accordingly, the rejections of claims 23-24 over Schena/Adams/Reber are similarly inadequate.

The next Action will be the fourth. No rejection has so-far required any amendment to the claims, each of which is still pending as originally filed. Despite repeated rejections involving different combinations of art, unpatentability has been established as to no claim. The Office is respectfully requested to bring this prolonged prosecution to a close, by issuance of a Notice of Allowance.

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Respectfully submitted,

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